UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,069	02/11/2004	Susan Q. Sanders	50160	2097

22929 7590 01/25/2007

SUE Z. SHAPER, P.C.
1800 WEST LOOP SOUTH
SUITE 1450
HOUSTON, TX 77027

EXAMINER	
MORRISON, JAY A	
ART UNIT	**PAPER NUMBER**
2168	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/776,069	SANDERS ET AL.	
	Examiner	Art Unit	
	Jay A. Morrison	2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Remarks

1. Claims 1-42 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Including "more than simply geographic" is not sufficiently described in the specification.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 16-18,22-26,36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites the limitation "TLD" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "TLD" in line 1. There is insufficient antecedent basis for this limitation in the claim.

The term "cutting edge technology" in claim 18 is a relative term which renders the claim indefinite. The term "cutting edge technology" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “more than simply geographic” does not sufficiently define what is being claimed.

Claim 24 recites the limitation "TLD" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 25 recites the limitation "TLD" in line 1. There is insufficient antecedent basis for this limitation in the claim.

The term "cutting edge technology" in claim 26 is a relative term which renders the claim indefinite. The term "cutting edge technology" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "more than simply geographic" does not sufficiently define what is being claimed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-11,13-37,39,41-42 are rejected under 35 U.S.C. 103(a) as being obvious over Pricewatch (www.pricewatch.com, webpages from 1/28/2003) in view of Yahoo (www.yahoo.com, webpages from 12/09/2002).

As per claim 1, Pricewatch teaches

An improved Internet Directory System, comprising: (page 1)

the plurality of CDWs each providing at least a lower level directory referencing websites (WSs) relating to a category; (page 2)

the CDWs being identified as Category Directory Websites participating in the System by at least a mark or a URL portion; (page 3)

and a business model imposed on at least the CDWs. (pages 4-5)

Pricewatch does not explicitly indicate "at least one upper-level Directory Provider (DP), providing a directory of at least upper-level fields and/or super-categories and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs)".

However, Yahoo discloses "at least one upper-level Directory Provider (DP), providing a directory of at least upper-level fields and/or super-categories and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs)" (page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "at least one upper-level Directory Provider (DP), providing a directory of at least upper-level fields and/or super-categories and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs)" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claim 2, Pricewatch teaches

the business model includes standards of operation imposed on the plurality of CDWs by the System. (page 5)

As per claim 3, Pricewatch teaches

a standard of operation includes professional management. (page 5)

As per claim 4, Pricewatch teaches

a standard of operation includes organization and comprehensiveness. (pages 1-3)

As per claim 5, Pricewatch teaches

a standard of operation includes up-to-dateness. (page 4)

As per claim 6, Pricewatch teaches

a standard of operation, imposed on at least a subset of CDWs, includes a CDW offering web sites at least one of an option to move to a secure site to negotiate a purchase and an organization of pertinent comparative data on a subject within the category. (page 3 and 5)

As per claim 7, Pricewatch teaches

the business model includes charging at least some WSs for being referenced. (page 5)

As per claim 8, Pricewatch teaches

the business model includes at least some WSs being charged for at least one service offered by a CDW. (page 5)

As per claim 9, Pricewatch teaches

the business model includes a participating CDW providing advertising space on its site. (page 3)

As per claim 10, Pricewatch teaches

the business model includes a CDW promoting, by advertising, at least one of its referenced websites. (page 3)

As per claim 11, Pricewatch teaches

the business model includes at least one advertising/promotion firm that provides advertising/promotion for a category and/or a CDW site substantially in return for advertising space on a CDW site. (page 3)

As per claim 13, Pricewatch teaches

the business model includes substantially funding operation of a CDW by payments from WSs. (page 4-5)

As per claim 14, Pricewatch teaches

the business model includes selection of categories for CDWs large enough to support a website and small enough to be managed according to the business plan. (page 1-2)

As per claim 15,

Pricewatch does not explicitly indicate "the business model includes contracting by at least one DP with a plurality of CDWs to secure a comprehensive listing of CDWs."

However, Yahoo discloses "the business model includes contracting by at least one DP with a plurality of CDWs to secure a comprehensive listing of CDWs." (page 1)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "the business model includes contracting by at least one DP with a plurality of CDWs to secure a comprehensive listing of CDWs" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claim 16, Pricewatch teaches

the URL portion comprises a TLD. (page 3)

As per claim 17, Pricewatch teaches

the URL portion comprises a TLD unique to CDWs and DPs in the system. (page 3)

As per claim 18, Pricewatch teaches

the business model includes at least one cutting edge technology cost effectively offered to appropriate referenced WSs. (page 3)

As per claim 19,

Pricewatch does not explicitly indicate "the plurality includes hundreds."

Yahoo discloses "the plurality" except for "the plurality includes hundreds". It would have been obvious to one having ordinary skill in the art at the time the invention was made to expand the plurality to include hundreds, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art (*St. Regis Paper Co. V. Bemis Co., 193 USPQ 8*).

As per claim 20,

Pricewatch does not explicitly indicate "the Directory Provider comprises an ISP or Search Engine."

However, Yahoo teaches "the Directory Provider comprises an ISP or Search Engine." (page 1)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "the Directory Provider comprises an ISP or Search Engine" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claim 21, Pricewatch teaches

1) the category and 2) at least one field and/or super-category are both more than simply geographic. (page 3)

As per claim 22, Pricewatch teaches

A method for providing an Internet Directory System, comprising: (page 1)

organizing an independent for-profit directory website to reference websites within a category; (page 3)

adopting a URL portion or a mark identifying said directory website as a participating Category Directory Website; (page 3)

and abiding by a System business model imposed on said Category Directory Websites. (pages 3-4)

Pricewatch does not explicitly indicate "participating in an Internet Directory System by said directory website by contracting to be referenced as one of a plurality of Category Directory Websites (CDW) on at least one independent upper-level Directory Provider's (DP) upper-level directory of at least fields and/or super-categories and categories, the upper-level directory referencing the CDWs".

However, Yahoo discloses "participating in an Internet Directory System by said directory website by contracting to be referenced as one of a plurality of Category Directory Websites (CDW) on at least one independent upper-level Directory Provider's (DP) upper-level directory of at least fields and/or super-categories and categories, the upper-level directory referencing the CDWs" (page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "participating in an Internet Directory System by said directory website by contracting to

be referenced as one of a plurality of Category Directory Websites (CDW) on at least one independent upper-level Directory Provider's (DP) upper-level directory of at least fields and/or super-categories and categories, the upper-level directory referencing the CDWs" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claims 23-36,

These claims are respectively rejected on grounds corresponding to the arguments given above for rejected claims 2,16-18,3-5,9-10,20,11,6-7,21 and are similarly rejected.

As per claim 37, Pricewatch teaches

the business model includes minimal standards for websites to be included in a directory, for updating website references including adding new websites and for deleting no longer viable websites and standards for certain quality of presentation for participating websites. (page 5)

As per claim 39, Pricewatch teaches

the upper level fields and/or super-categories being organized to contain CDWs which pay the DP to be listed in one or more fields, the fee based on a number of web pages hosted or linked to the CDW. (page 5)

As per claim 41, Pricewatch teaches

the plurality includes thousands. (page 3)

As per claim 42, Pricewatch teaches

the CDWs providing lists of business and/or web pages within their category and organizing those lists into sub-categories. (page 2)

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pricewatch and Yahoo, and further in view of Morimoto (Publication Number 2002/0013774).

As per claim 12,

Pricewatch as modified with Yahoo do not explicitly indicate "the business model includes offering webpage enhancement services at a volume discount."

However, Morimoto discloses "the business model includes offering webpage enhancement services at a volume discount" (paragraph [0008]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo, and Morimoto because using the steps of "the business model includes offering webpage enhancement services at a volume discount" would have given those skilled in the art the tools to improve the

invention by allowing economies of scale to determine prices. This gives the user the advantage of being able to get better prices if willing to spend more money.

8. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pricewatch and Yahoo, and further in view of eBay (www.ebay.com webpages from 11/15/2002).

As per claim 38,

Pricewatch does not explicitly indicate "the business model includes the CDW being substantially funded through an offer of enhanced listings and value added services, including cutting-edge technology where appropriate, to web sites, such services tailored to a category and specifically designed to attract and retain viewers".

However, eBay discloses "the business model includes the CDW being substantially funded through an offer of enhanced listings and value added services, including cutting-edge technology where appropriate, to web sites, such services tailored to a category and specifically designed to attract and retain viewers" (table 6, listing enhancements).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo, and eBay because using the steps of "the business model includes the CDW being substantially funded through an offer of enhanced listings and value added services, including cutting-edge technology where appropriate, to web sites, such services tailored to a category and specifically designed

to attract and retain viewers" would have given those skilled in the art the tools to improve the invention by allowing enhancement of listings. This gives the user the advantage of being able to have options to help attract more buyers.

9. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pricewatch and Yahoo, and further in view of Google (www.google.com webpages from 2/22/2002).

As per claim 40,

Pricewatch does not explicitly indicate "the CDWs contracting with an advertising/promotion firm for design, marketing and/or promotional services to be provided at no cost to the CDW while the advertising/promotional firm sells advertising spots on the CDW and collects the revenue generated".

However, Google discloses "the CDWs contracting with an advertising/promotion firm for design, marketing and/or promotional services to be provided at no cost to the CDW while the advertising/promotional firm sells advertising spots on the CDW and collects the revenue generated" (page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo, and Google because using the steps of "the CDWs contracting with an advertising/promotion firm for design, marketing and/or promotional services to be provided at no cost to the CDW while the advertising/promotional firm sells advertising spots on the CDW and collects the

revenue generated" would have given those skilled in the art the tools to improve the invention by allowing enhancement of listings. This gives the user the advantage of being able to have options to help attract more buyers.

Response to Arguments

10. Applicant's arguments filed 10/25/06 have been fully considered but they are not persuasive.

With regards to Applicants argument that TLD is widely used as "top level domain", it is still necessary to specify the exact meaning of the acronym. Therefore the rejections are maintained.

With regards to Applicants argument that "more than simply geographic" is sufficiently disclosed in the Application, the only reference to geographic in the specification refers to "geographic region" which does not sufficiently disclose "more than simply geographic". Therefore the rejections are maintained.

With regards to Applicants argument that "cutting edge technology" is not "impermissibly indefinite", that new technologies are discussed in the application, it is respectfully submitted that the new technologies do not yet exist and therefore cannot be sufficiently described. Therefore the rejections are maintained.

With regards to Applicant's argument that Pricewatch does not disclose "the CDWs being identified as category directory websites participating in the system by at least a mark or a URL portion" or "adopting a URL portion or a mark identifying said directory website as a participating category directory website", it is noted that

Pricewatch discloses "Buy Online" links (URLs) which identifying the directory website as participating (page 3). Therefore it is respectfully submitted that Pricewatch discloses the limitation.

With regards to Applicant's argument that Pricewatch does not disclose "a business model imposed on at least the CDWs" or "abiding by a system business model imposed on said category directory website", it is noted that Pricewatch discloses requirements of the advertisers which are imposed and must be abided (page 5). Therefore it is respectfully submitted that Pricewatch discloses the limitation.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action (with regards to new claims). Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record, listed on form PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay A. Morrison whose telephone number is (571) 272-7112. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jay Morrison
TC2100

Tim Vo
TC2100

Primary Examiner
1/22/07